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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 044182-0305880 | | | | | | | | | | | | | | | |
|---|---|--|--|--|---|---|-------------------------------|--|-----------------------|---------------------------|--------------|--|------------------|--|------------------|---|------|
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____ | Application Number 10/656,002 | Filed September 5, 2003 | | | | | | | | | | | | | | | |
| | First Named Inventor Steven S. Reese | | | | | | | | | | | | | | | | |
| | Art Unit 3752 | Examiner BOECKMANN, Jason J | | | | | | | | | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td></td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Signature Anthony G. Smyth</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. 55636</td><td>Typed or printed name</td></tr><tr><td>Registration number _____</td><td>858.509.4007</td></tr><tr><td></td><td>Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.</td><td>November 9, 2006</td></tr><tr><td>Registration number if acting under 37 CFR 1.34 _____</td><td>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | | <input type="checkbox"/> applicant/inventor. |  | <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | Signature Anthony G. Smyth | <input checked="" type="checkbox"/> attorney or agent of record. 55636 | Typed or printed name | Registration number _____ | 858.509.4007 | | Telephone number | <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. | November 9, 2006 | Registration number if acting under 37 CFR 1.34 _____ | Date |
| <input type="checkbox"/> applicant/inventor. |  | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | Signature Anthony G. Smyth | | | | | | | | | | | | | | | | |
| <input checked="" type="checkbox"/> attorney or agent of record. 55636 | Typed or printed name | | | | | | | | | | | | | | | | |
| Registration number _____ | 858.509.4007 | | | | | | | | | | | | | | | | |
| | Telephone number | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. | November 9, 2006 | | | | | | | | | | | | | | | | |
| Registration number if acting under 37 CFR 1.34 _____ | Date | | | | | | | | | | | | | | | | |
| <input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted. | | | | | | | | | | | | | | | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket: 044182-0305880

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: STEVEN S. REESE, ET AL.

Confirmation Number: 7517

Application No.: 10/656,002

Group Art Unit: 3752

Filed: September 5, 2003

Examiner: BOECKMANN, Jason J.

Title: SUBSTRATE HOLDER

**Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

Pre-Appeal Brief Request for Review

This brief is submitted concurrently with a Notice of Appeal in the above-listed Application. The Notice of Appeal is timely filed in response to the Office Action mailed on August 9th, 2006. An Advisory Action was mailed October 18th, 2006 in response to an After Final amendment filed by Applicant on October 10th, 2006.

REMARKS

In the Office Action of August 9, 2006 ("FOA"), claims 1, 2, 4-7, 9, 12-15, 17, 19 and 20 were finally rejected under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent 4,262,991 to Wagener et al. ("Wagener"). Claims 8, 16 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wagener in view of U.S. Patent 5,900,708 to Den Engelse et al. ("Den Engelse"). However, it is unnecessary to address the §103 rejections of claims 8, 16 and 18 here because these rejections are predicated on the ill-founded §102 rejections of claims 1 and 9. See FOA, paragraph spanning pages 4 and 5.

Applicant respectfully submits that Wagener does not teach every element of the claimed inventions arranged as in the claims. A cited prior art reference anticipates a claimed invention under 35 U.S.C. §102 only if every element of the claimed invention is identically shown in the single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 USPQ 2d 1566, 1567 (Fed. Cir. 1990). Each and every limitation of the claimed invention is significant and must be found in the single cited prior art reference. *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985). As set forth more fully below, Wagener does not disclose each and every element of the claims arranged as they are in the claims. Furthermore, the Office Action disregards the significance of certain claim elements by suggesting that a single feature taught by Wagener anticipates distinctly different elements of the claims in the present Application.

In rejecting claims 1 and 9, the Examiner alleges that a base plate, a fixed part 9 and a stage plate 1 in Wagener disclose the claimed elements of a precision stage, a fixed portion and a movable portion arranged as they are in the claims. The Examiner's allegation is factually incorrect.

Claims 1 and 9 of the present Application require, *inter alia*, a fixed portion configured and operative to be attached to a precision stage, a movable portion operably coupled to said fixed portion and selectively movable relative thereto. Wagener does not explicitly or impliedly teach a fixed portion, a precision stage and a movable portion and does not teach an arrangement of these elements as recited in the claims. Furthermore, the Examiner has repeatedly failed to provide any citation to a drawing or description in Wagener that shows **all three** of these elements, arranged as recited in the claims.

Wagener Does Not Teach A Base Plate Separate And Distinct From A Fixed Part

In the Office Action, the Examiner cites a base plate, a fixed part 9 and a stage plate 1 as supposedly showing the required precision stage, fixed part and movable portion, respectively. However, the cited base plate is not identified in any drawing of Wagener and no explicit description of a base plate can be found in the “Description” section of Wagener. The term “base plate” is used exclusively in the Abstract and in claims 1-3 of Wagener. In contrast, the term “fixed part” does not appear in the Abstract or in claims 1-3 of Wagener, but a “fixed part 9” is identified in the drawings, described in the “Description” section and claimed in claims 4-6 of Wagener. The terms “base plate” and “fixed part 9” never appear in the same part or section of Wagener because the terms describe the same feature.

Closer examination of the Wagener claims confirms that the “base plate” and “fixed part” are not distinctly different elements. In relevant part, claim 4 of Wagener recites:

...a base plate adapted for fixed mounting on a microscope frame, a stage plate carried by said base plate and having a first guided suspension with respect to said base plate along a first axis, a first movable member disposed between said base plate and said stage plate...said first suspension comprising two spaced parallel first-axis guides in said base plate, said stage plate having direct laterally guided abutment with the first of said first-axis guides and having indirect laterally guided abutment with the second of said first-axis guides...

In particular, Wagener’s claimed “base plate adapted for fixed mounting on a microscope frame” claim 4 can only be supported by Wagener’s teaching of “a fixed part 9, which is connected with the microscope” when the term “fixed part 9” is equated with the term “base plate.” Wagener, col. 2, lines 7-10. Further, Wagener teaches fixed part 9 having two grooves 10, 11 in which wire-race ball-bearing linear guides are arranged that correspond directly to the “two spaced parallel first-axis guides in said base plate” recited in claim 4 of Wagener. Wagener, col. 2, lines 10-12. Other than teachings directed to “fixed part 9,” nothing in Wagener supports the recitation of function and structure associated with Wagener’s claims “base plate.”

The absence of a detailed description in Wagener of a “base plate” and the failure of Wagener’s drawings to explicitly show a “base plate” can be reconciled with Wagener’s recitations of “base plate” in claims 4-6 and the Abstract only if the terms “base plate” and “fixed part 9” are different names for the same Wagener feature. Therefore, it is unreasonable to suggest that Wagener’s “fixed part 9” anticipates both a fixed part and a distinct precision stage and the rejections of claims 1 and 9 are improper.

Wagener Does Not Teach An Arrangement Of Elements As Recited In Claims 1 And 9

Even allowing *arguendo*, the Examiner's proposition that a base plate and a fixed part might be distinctly found in Wagener, the rejection is nevertheless improper because these alleged elements are not identically shown in Wagener, arranged as they are in the claims. See MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 USPQ 2d 1566, 1567 (Fed. Cir. 1990). In the Final Office Action, the Examiner rejected the claims alleging that:

- (i) the required precision stage is taught as Wagener's base plate,
- (ii) the required fixed portion is taught as Wagener's fixed part 9, and
- (iii) the required movable portion is taught as Wagener's stage plate 1.

Nevertheless, Wagener nowhere teaches an arrangement of elements that includes a base plate, a fixed part and a stage plate. More specifically:

- the terms "fixed part" and "base plate" are never found in the same claim;
- the terms "fixed part" and "base plate" are not found together in the Abstract;
- the terms "fixed part" and "base plate" are not found together in the Description" section;
- no drawing shows a "fixed part" and a distinct "base plate."

Therefore, the rejections of claims 1 and 9 are improper for the additional reason that "base plate" and "fixed part" features are never disclosed together in any arrangement or combination of features or elements of Wagener, notwithstanding the Examiner's unfounded assertion that each of these features anticipate a distinctly different required element of recited in claims 1 and 9 in the present Application.

CONCLUSION

For at least the reasons provided above, Wagener cannot be said to disclose each and every element of claims 1 and 9, arranged as they are in claims 1 and 9 and the §102 rejections of claims 1 and 9 should be withdrawn. Claims 2, 4-7, 12-15, 17, 19 and 20 depend ultimately from either claim 1 or claim 9 and these dependent claims are allowable for at least the reasons that claims 1 and 9 are allowable. Moreover, the §103 rejections of claims 8, 16 and 18 are improper because Wagener does not teach all elements and arrangements of claims 1 and 9 and Den Engelse cannot cure the deficiencies of Wagener. Therefore, the rejections of all claims in the Application should be withdrawn and a Notice of Allowance should be issued.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP



ANTHONY G. SMYTH, Reg. No. 55,636
Tel. No. 858 509.4007

Date: November 9, 2006
11682 El Camino Real
Suite 200
San Diego, CA 92130-2092
(619) 234-5000